

REMARKS

Applicant respectfully request entry of the following amendments and remarks in response to the Office Action mailed January 15, 2008. Applicant respectfully submit that the amendments and remarks contained herein place the instant application in condition for allowance.

Upon entry of the amendments in this response, claims 21 – 33 and 35 – 40 are pending. In particular, Applicant adds claim 41, amends claims 21, 23 – 25, 28, 30 – 31, 33, 35, and 37 – 39 and cancels claim 34 without prejudice, waiver, or disclaimer. Applicant cancels claim 34 merely to reduce the number of disputed issues and to facilitate early allowance and issuance of other claims in the present application. Applicant reserves the right to pursue the subject matter of these canceled claims in a continuing application, if Applicant so chooses, and does not intend to dedicate the canceled subject matter to the public. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

I. Rejections Under 35 U.S.C. §101

The Office Action indicates that claims 28 – 34 stand rejected under 35 U.S.C. §101 as claiming allegedly that the invention is directed to non-statutory subject matter. Applicant amends claim 28, to recite “providing, by the electronic device, the combined score to the user,” as indicated above. Pursuant to MPEP §2106(II)(A), which states “[o]nly when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. 101,” Applicant submits that this amendment fully complies with the requirements of 35 U.S.C. §101.

II. Rejections Under 35 U.S.C. §112

The Office Action indicates that claims 23 – 25, 30 – 32, and 37 – 39 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement.

Applicant amends these claims and submits that claims 23 – 25, 30 – 32, and 37 – 39, as amended, meet all the requirements of 35 U.S.C. §112. More specifically, MPEP §2164.01 states:

The standard for determining whether the specification meets the enablement requirement [of 35 U.S.C. §112] was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916) which postured the question: ***is the experimentation needed to practice the invention undue or unreasonable?*** That standard is still the one to be applied. In re *Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). Accordingly, even though the statute does not use the term "undue experimentation," it has been interpreted to require that the claimed invention be enabled so that any person skilled in the art can make and use the invention without undue experimentation. In re *Wands*, 858 F.2d at 737, 8 USPQ2d at 1404 (Fed. Cir. 1988). See also *United States v. Electronics, Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988) ("The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.").

(emphasis added)

Applicant respectfully submits that these claims, as amended, are fully enabled, pursuant to 35 U.S.C. §112 for at least the reason that undue experimentation is not required for making or using the claimed invention. More specifically, determining a likelihood (or risk for that matter) has a finite range from which to select (between 0% and 100%). Thus, in order to make the claimed invention, one or ordinary skill need only make a determination of the likelihood and classify a level of risk, as disclosed on page 14, paragraph [0053], among other places, of the written description. Similarly, no experimentation would be needed to use the claimed invention. For at least these reasons, claims 23 – 25, 30 – 32, and 37 – 39, as amended, meet all the requirements of 35 U.S.C. §112.

Additionally, the Office Action indicates that claims 23 – 25, 30 – 32, and 37 – 39 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant amends claims 23 – 25, 30 – 32, and 37 – 39 and submits that these claims, as

amended, meet all the requirements of 35 U.S.C. §112. Applicant submits that for at least the reason that the likelihood of an one of the listed events occurring is between 0% and 100%, the metes and bounds are necessarily within the scope of the specification. For at least these reasons, claims 23 – 25, 30 – 32, and 37 – 39 meet all the requirements of 35 U.S.C. §112.

III. Rejections Under 35 U.S.C. §103

A. Claim 21 is Allowable Over Woods in view of Clark

The Office Action indicates that claim 21 stands rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over U.S. Patent Number 6,101,491 (“*Woods*”) in view of U.S. Publication Number 2004/0153663 (“*Clark*”). Applicant respectfully traverses this rejection for at least the reason that *Woods* in view of *Clark* fails to disclose, teach, or suggest all of the elements of claim 21. More specifically, claim 21 recites:

A computer-readable medium comprising:

computer-readable code adapted to instruct a programmable device to search for a first piece of sensitive information, the first piece of sensitive information including personal information regarding at least one user;

computer-readable code adapted to instruct a programmable device to search for a second piece of sensitive information, the second piece of sensitive information including personal information regarding the at least one user;

computer-readable code adapted to instruct a programmable device to obtain a result of the search for the first piece of sensitive information, ***the first piece of sensitive information being of a first type***;

computer-readable code adapted to instruct a programmable device to obtain a result of the search for the second piece of sensitive information, ***the second piece of sensitive information being of a second type, the first type of information being different than the second type of information***;

computer-readable code adapted to instruct a programmable device to assign a first score, the first score being determined from the number of occurrences of the first piece of sensitive data, as revealed in the search for the first piece of sensitive data;

computer-readable code adapted to instruct a programmable device to assign a second score, the second score being determined from the number of occurrences of the first

piece of sensitive data, as revealed in the search for the first piece of sensitive data;

computer-readable code adapted to instruct a programmable device to combine the first score and the second score;

computer-readable code adapted to instruct a programmable device to provide the combined score to a user; and

computer-readable code adapted to instruct a programmable device to determine, from the combined score, a risk for at least one identity-related vulnerability.

(Emphasis added)

Applicant respectfully submits that claim 21 is allowable for at least the reason that neither *Woods* nor *Clark*, taken alone or in combination, discloses, teaches, or suggests a “computer-readable medium comprising... computer-readable code adapted to instruct a programmable device to obtain a result of the search for the first piece of sensitive information, ***the first piece of sensitive information being of a first type...*** [and] computer-readable code adapted to instruct a programmable device to obtain a result of the search for the second piece of sensitive information, ***the second piece of sensitive information being of a second type,*** ***the first type of information being different than the second type of information***” as recited in claim 21. More specifically, *Woods* discloses a “[q]uery dispatcher/aggregator 130 [that]... merges the hits and scores from the various index managers” (column 9, line 28). However, the information in *Woods* from which the hits are derived appear to be the same type of information for all index managers. Accordingly, *Woods* fails to disclose or suggest “computer-readable code adapted to instruct a programmable device to obtain a result of the search for the first piece of sensitive information, ***the first piece of sensitive information being of a first type...*** [and] computer-readable code adapted to instruct a programmable device to obtain a result of the search for the second piece of sensitive information, ***the second piece of sensitive information being of a second type,*** ***the first type of information being different than the second type of information***” as recited in claim 21.

Additionally, *Clark* fails to overcome the deficiencies of *Woods*. More specifically, *Clark* states “gather[ing] and analyz[ing] demographic data associated with a change in address (FIG. 1, element 14). However, *Clark* fails to disclose or suggest “computer-readable code adapted to instruct a programmable device to obtain a result of the search for the first piece of sensitive information, ***the first piece of sensitive information being of a first type***... [and] computer-readable code adapted to instruct a programmable device to obtain a result of the search for the second piece of sensitive information, ***the second piece of sensitive information being of a second type, the first type of information being different than the second type of information***” as recited in claim 21. For at least these reasons, claim 21 is allowable.

B. Claim 28 is Allowable Over Woods in view of Clark

The Office Action indicates that claim 28 stands rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over U.S. Patent Number 6,101,491 (“*Woods*”) in view of U.S. Publication Number 2004/0153663 (“*Clark*”). Applicant respectfully traverses this rejection for at least the reason that *Woods* in view of *Clark* fails to disclose, teach, or suggest all of the elements of claim 28. More specifically, claim 28 recites:

A method comprising:

searching for a first piece of sensitive information, the first piece of sensitive information including personal information regarding at least one user;

searching for a second piece of sensitive information, the second piece of sensitive information including personal information regarding the at least one user;

obtaining a result of the search for the first piece of sensitive information, ***the first piece of sensitive information being of a first type***;

obtaining a result of the search for the second piece of sensitive information, ***the second piece of sensitive information being of a second type, the first type of information being different than the second type of information***;

assigning a first score, the first score being determined from the number of occurrences of the first piece of sensitive data, as revealed in the search for the first piece of sensitive data;

assigning a second score, the second score being determined from the number of occurrences of the second piece

of sensitive data, as revealed in the search for the second piece of sensitive data;

combining, by an electronic device, the first score and the second score;

providing, by the electronic device, the combined score to a user; and

determining, from the combined score, a risk for at least one identity-related vulnerability.

(Emphasis added)

Applicant respectfully submits that claim 28 is allowable for at least the reason that neither *Woods* nor *Clark*, taken alone or in combination, discloses, teaches, or suggests a “method comprising... obtaining a result of the search for the first piece of sensitive information, ***the first piece of sensitive information being of a first type***... [and] obtaining a result of the search for the second piece of sensitive information, ***the second piece of sensitive information being of a second type, the first type of information being different than the second type of information***” as recited in claim 28. More specifically, *Woods* discloses a “[q]uery dispatcher/aggregator 130 [that]... merges the hits and scores from the various index managers” (column 9, line 28). However, the information in *Woods* from which the hits are derived appear to be the same type of information for all index managers. Accordingly, *Woods* fails to disclose or suggest “obtaining a result of the search for the first piece of sensitive information, ***the first piece of sensitive information being of a first type***... [and] obtaining a result of the search for the second piece of sensitive information, ***the second piece of sensitive information being of a second type, the first type of information being different than the second type of information***” as recited in claim 28.

Additionally, *Clark* fails to overcome the deficiencies of *Woods*. More specifically, *Clark* states “gather[ing] and analyz[ing] demographic data associated with a change in address (FIG. 1, element 14). However, *Clark* fails to disclose or suggest “obtaining a result of the search for the first piece of sensitive information, ***the first piece of sensitive information being of a first type***... [and] obtaining a result of the search for the second piece of sensitive information, ***the second piece of sensitive information being of a second type, the first type of information being different than the second type of information***” as recited in claim 28.

information being different than the second type of information" as recited in claim 28. For at least these reasons, claim 28 is allowable.

C. Claim 35 is Allowable Over Woods in view of Clark

The Office Action indicates that claim 35 stands rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over U.S. Patent Number 6,101,491 ("Woods") in view of U.S. Publication Number 2004/0153663 ("Clark"). Applicant respectfully traverses this rejection for at least the reason that *Woods* in view of *Clark* fails to disclose, teach, or suggest all of the elements of claim 35. More specifically, claim 35 recites:

A system comprising:

a first searching component configured to search for a first piece of sensitive information, the first piece of sensitive information including personal information regarding at least one user;

a second searching component configured to search for a second piece of sensitive information, the second piece of sensitive information including personal information regarding the at least one user;

a first obtaining component configured to obtain a result of the search for the first piece of sensitive information, ***the first piece of sensitive information being of a first type;***

a second obtaining component configured to obtain a result of the search for the second piece of sensitive information, ***the second piece of sensitive information being of a second type, the first type of information being different than the second type of information;***

a first assigning component configured to assign a first score, the first score being determined from the number of occurrences of the first piece of sensitive data, as revealed in the search for the first piece of sensitive data;

a second assigning component configured to assign a score, the second score being determined from the number of occurrences of the second piece of sensitive data, as revealed in the search for the second piece of sensitive data;

a combining component configured to combine the first score and the second score;

a providing component configured to provide the combined score to a user; and

a determining component configured to determine, from the combined score, a risk for at least one identity-related vulnerability.

(Emphasis added)

Applicant respectfully submits that claim 35 is allowable for at least the reason that neither *Woods* nor *Clark*, taken alone or in combination, discloses, teaches, or suggests a “system comprising... a first obtaining component configured to obtain a result of the search for the first piece of sensitive information, ***the first piece of sensitive information being of a first type***... [and] a second obtaining component configured to obtain a result of the search for the second piece of sensitive information, ***the second piece of sensitive information being of a second type, the first type of information being different than the second type of information***” as recited in claim 35. More specifically, *Woods* discloses a “[q]uery dispatcher/aggregator 130 [that]... merges the hits and scores from the various index managers” (column 9, line 28). However, the information in *Woods* from which the hits are derived appear to be the same type of information for all index managers. Accordingly, *Woods* fails to disclose or suggest “a first obtaining component configured to obtain a result of the search for the first piece of sensitive information, ***the first piece of sensitive information being of a first type***... [and] a second obtaining component configured to obtain a result of the search for the second piece of sensitive information, ***the second piece of sensitive information being of a second type, the first type of information being different than the second type of information***” as recited in claim 35.

Additionally, *Clark* fails to overcome the deficiencies of *Woods*. More specifically, *Clark* states “gather[ing] and analyz[ing] demographic data associated with a change in address (FIG. 1, element 14). However, *Clark* fails to disclose or suggest “a first obtaining component configured to obtain a result of the search for the first piece of sensitive information, ***the first piece of sensitive information being of a first type***... [and] a second obtaining component configured to obtain a result of the search for the second piece of sensitive information, ***the second piece of sensitive information being of a second type, the first type of***

information being different than the second type of information" as recited in claim 35. For at least these reasons, claim 35 is allowable.

D. Claims 22 – 27, 29 – 34, and 36 – 40 are Allowable Over Woods in view of Clark

The Office Action indicates that claims 22 – 27, 29 – 34, and 36 – 40 stand rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over U.S. Patent Number 6,101,491 ("Woods") in view of U.S. Publication Number 2004/0153663 ("Clark"). Applicant respectfully traverses this rejection for at least the reason that Woods in view of Clark fails to disclose, teach, or suggest all of the elements of claims 22 – 27, 29 – 34, and 36 – 40. More specifically, dependent claims 22 – 27 are believed to be allowable for at least the reason that these claims depend from and include the elements of allowable independent claim 21. Further, dependent claims 29 – 34 and 36 – 40 are believed to be allowable for at least the reason that they depend from and include the elements of allowable independent claim 28. *In re Fine, Minnesota Mining and Mfg. Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

IV. Allegedly Well Known Subject Matter

Additionally, in rejecting claims 21, 28, and 35, the Office Action states "[i]t is well known to an ordinary skilled artisan in the searching arts that searching and matching data generates hits... it is [also] well known to an ordinary artisan skilled in the searching arts that searches may be provided against any data available in the database or the world wide web, including personal user profiles" (OA page 8, last paragraph). Applicant respectfully traverses the alleged finding of well known subject matter and submit that the subject matter noted above should not be considered well known for at least the specific and particular reason that the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions, as required. Additionally, Applicant submits that merely providing

a reference (or a couple of references) that allegedly discloses the subject matter in question, does not rise to an evidentiary level of being well known in the industry. Applicant submits that even if the cited references disclose the subject matter in question (a point that the Applicant is not conceding), presence of that subject matter in a reference does not raise the level of commonality of that subject matter to something of unquestionable fact. For at least this specific and particular reason, Applicant submits that the subject matter in question is not well known in the art.

Applicant additionally submits that particularly in the context of the claimed combination that includes combining the first score and the second score, the subject matter in question is too complex for a reasonably skilled person to consider it to be well known to the point that no additional evidence is needed. For at least this additional specific and particular reason, Applicant respectfully submits that the subject matter in question is not well known in the art, respectfully traverses the alleged well known finding, and submits that claim 21, 28, and 35 are patentable in view of the cited art.

CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicant respectfully submit that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested.

Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and Official Notice, or statements interpreted similarly, should not be considered well-known for the particular and specific reasons that the claimed combinations are too complex to support such conclusions and because the Office Action does not include specific findings predicated on sound technical and scientific reasoning to support such conclusions.

If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

/afb/
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